

## **REMARKS**

### ***Summary of Changes Made***

The Application was filed with 12 claims. In previous amendments, claims 2-6 have been canceled. Claims 1 and 12 are amended herein. A substitute specification is provided as evidence of a corrected translation of the priority document. Accordingly, claims 1 and 7-12 remain pending for the Examiner's consideration. No new matter is added herewith.

### ***Specification Objection - 35 U.S.C. 132(a)***

The Examiner objects to the amendment filed 16 March 2009 under 35 U.S.C. 132(a) for an alleged introduction of new matter to the disclosure. In particular, the Examiner believes that the deletion of the statement "polyamide, polymethyl methacrylate and ethyl carbamate" from the recitation of swelling lipophilic bases constitutes new matter.

The Examiner will note that the specification amendment is included herewith (substitute specification) which is a corrected translation of the PCT application that parents the present application. A declaration by the translator verifies the accuracy of the translation. Relevant to the corrected translation, the Examiner is also referred to the Declaration of Yuji Iwahashi, the Applicant's Japanese Patent Counsel, which is of record, having been filed 16 March 2009.

The substitute specification is a corrected translation as noted in the Declaration of Kanako Ohtsuka, enclosed herewith, styled "Verification of Translation." The amendment in paragraph [0049] corrects an erroneous translation of that paragraph. Paragraph [0031] of the priority document (JP 2004-217621) was erroneously translated to state that the lipophilic base powder may be any of "silicone resin, silicone rubber, silicone resin-covering-silicone rubber, polyamide, polymethyl methacrylate, and ethyl carbamate." Paragraph [0049] of the instant specification was the result of the erroneous translation. The new, corrected, translation of paragraph [0049] discloses that the lipophilic base powder may be any of silicone resin, silicone rubber, or silicone resin-covered-silicone rubber. The declaration of Kanako Ohtsuka certifies the accuracy of the corrected translation. Because the substitute specification is an accurate translation of the priority document, this amendment adds no new matter.

***Claim Rejections (35 U.S.C. §103 – Nakane/Kobayashi)***

Claims 1 and 7-12 are rejected under 35 U.S.C. §103(a) as obvious over U.S. Patent Number 5,122,418 to Nakane et al., (“Nakane”) in view of U.S. Patent Number 5,928,660 to Kobayashi, et al., (“Kobayashi”). Nakane relates to a composition including a complex powder including lipophilic base powder coated with zinc oxide, and an oil component. The base powder is exemplified by polymethyl methacrylate and the oil is a silicone oil. The Examiner contends that Example 25 of Nakane discloses “30% zinc oxide covered polymethyl methacrylate (7%) in the form of an emulsion in silicone oil (dimethylpolysiloxane 10%).” The Examiner admits that Nakane fails to teach a composition including a lipophilic base powder selected from the group consisting of silicone resin, silicone rubber and silicone resin-covered silicone rubber.

Accordingly the Examiner cites Kobayashi as allegedly teaching a cosmetic comprising powdered silicone rubber. Using an aqueous suspension of a powdered silicon rubber containing a non-crosslinked oil causes a softening feeling of the skin and improves cosmetic durability wherein the oil impregnates (swells) the powdered silicone rubber. It is desirable to have the content of the non-cross-linked oil in the powdered silicone rubber 80% or less, preferably 50%. A powdered silicone rubber whose surface is covered by a fine inorganic powder shows good stability, and useful inorganic powders include zinc oxide.

With respect to the Kobayashi reference, the cosmetic raw material disclosed therein includes an aqueous suspension of a powdered silicone rubber with a mean particle size of 0.1 to 500 microns (a 5000 fold difference in from the top to the bottom boundary of that range.) The aqueous suspension of powdered silicone rubber therein is obtained by curing a silicone rubber composition dispersed in water in the form of fine particles containing a non-crosslinked oil. This means the powdered silicone rubber contains oil at the time of being produced as particles for cosmetics. The powdered silicone rubber as disclosed by Kobayashi may have swelled because it is impregnated by a non-cross-linked oil during its production process (column 3, lines 8-23).

The Examiner will note that claims 1 and 12 have been amended to recite that the zinc oxide covers the lipophilic base powder at a rate of 5 to 50% of the total surface area of the lipophilic base powder which is dispersed in an oil component. This range is supported in the specification in tables 8 and 9. Within this covering rate range, the dispersibility in oil is

good, and the effect on treating rough skin is excellent. This amendment alone removes the claimed subject matter from the purview of the cited Nakane and Kobayashi references, in any combination.

The Examiner appears to equate the weight percentages in various of Nakane's examples with surface area covering percentages as instantly claimed. This interpretation is not supported by the disclosures of Nakane. Indeed, looking to Example 7 of Nakane, it is clear that "40% titanium oxide covered spherical cellulose," means 40% by weight. Indeed, Nakane discloses,

In the same way as in Example 1, 60 parts of spherical cellulose powder (average particle size 20 microns) were mixed with 40 parts of titanium dioxide powder (average particle size 0.2 micron) in a Henschel mixer for 5 minutes, then the obtained mixed powder was mixed and compressed in a vibration ball mill charged with alumina balls (Nippon Kagaku Tokyo Co., HD alumina balls, 2 mm  $\Phi$ ) for 20 hours.

Considering above description, it can be understood that "40%" represents the weight percentage of titanium dioxide in complex powder. Further evidence that Nakane's convention with respect to percentages refers to weight (and not surface area covering rate) can be found in the asterisked footnotes for examples 8-11, found immediately beneath the respective formulation tables. It is thus clear, that the Examiner's citation of Nakane's Example 25 refers to a covered powder having 30% by weight of zinc oxide and 70 % by weight of polymethyl methacrylate.

The broad and narrow teachings, of Nakane, for example in the first paragraph of the specification, point to:

a composite powder wherein the surface of one type of core powder is **substantially completely covered** with another type of coating powder, thereby improving the surface characteristics of the powder (emphasis supplied).

Indeed, the phrase "substantially completely" appears 24 times in the specification and claims of Nakane, in reference to the covering rate of a core powder by one or more types of organic, inorganic or metallic powders. Accordingly, the skilled artisan finds absolutely no

motivation or suggestion therein to cover a core powder at a rate anything less than “substantially completely.”

In addition, because Example 25 relates to a “sunburn preventing lotion,” the skilled artisan immediately recognizes that zinc oxide is used as a sunscreen agent, as is known in the art. It is therefore unlikely that the skilled artisan would reduce the covering rate of zinc oxide to the range of 5-50% of the surface area of the base powder. Higher zinc oxide content leads to a better suncreening effect, which would be the only goal of a sunscreen agent.

Additionally, the silicone oil component of Example 25 does not correspond to the silicone resin and/or silicone rubber base powders instantly claimed. Further, the core powder of Nakane is not a swelling powder. As noted in paragraph 49 of the instant specification (as amended), the powders employed by Nakane, such as polyamide (nylon) and polymethyl methacrylate, are not swelling powders. Hence, Nakane fails to disclose a powder that is both lipophilic and that swells in oil.

The instantly claimed base powders, selected from silicone resin, silicone rubber, and silicone resin-covered-silicone rubber, are swellable in oil, and as such, can adsorb a plasminogen activator, as shown in Figure 1, and as disclosed in at least paragraphs [0007], [0019], and [0027] of the specification. Nakane further fails to disclose the limitation that the base powder is swelled in oil. Nakane fails to disclose that the base powder is silicone resin, silicone rubber, or silicone resin-covered- silicone rubber.

Although the powdered silicone rubber is produced as an aqueous suspension, Kobayashi also disclosed the powder as being devoid of water content and it has been blended with oil components to produce cosmetics. Therefore, Kobayashi teaches impregnating the powdered silicone rubber with oil and blending the oil-swelled silicone rubber into an oily external composition.

However, Kobayashi fails to teach or disclose covering the powdered silicone rubber with zinc oxide at a surface area covering rate of 5-50%. Kobayashi discloses a powdered silicone rubber whose surface is covered with a fine inorganic powder. The fine inorganic powder could be zinc oxide, and it is used to provide the powdered silicone rubber with good dispersibility and the capacity to absorb ultraviolet radiation. Higher dispersibility and UV absorption are achieved by higher covering rates, (a lower covering rate allows the silicone

rubber particles of Kobayashi to agglomerate). Therefore, the skilled artisan does not learn from Kobayashi a covering rate of 5-50%.

Also, the complex powder of the present invention cannot be derived from Kobayashi's method for covering a silicone rubber powder with fine inorganic powder (zinc oxide). Kobayashi discloses a method of adding a fine organic powder (zinc oxide) to an aqueous suspension of a powdered silicone rubber, and the surface of the powdered silicone rubber is coated with this fine inorganic powder under agitation. "Powdered silicone rubber" in this method is an oil-impregnated powder, that is: the powder was previously swelled with oil before it was coated with the fine organic powder. Accordingly, in Kobayashi's method, zinc oxide would uniformly and completely cover the surface of the swelled powdered silicone rubber. Nothing in Kobayashi leads to another conclusion relative to covering rate.

Further, although Kobayashi has disclosed cosmetics where the powdered silicone rubber (devoid of water) is blended with oil components, these are Comparative Examples, which represent the prior art which Kobayashi is trying to overcome and surpass. Hence, a reading of Kobayashi does not lead one to practice the subject matter taught in its comparative examples.

On the other hand, in the presently claimed complex powder, a lipophilic base powder (silicon rubber) must be dispersed into oil components. This leads to the specific covering rate 5-50% because of oil-swelling the base powder as shown in Figure 1. Thus, the oily external composition of the present invention contradicts the intent of Kobayashi, so it is impossible for one skilled in the art to expect the present invention from Kobayashi's teaching.

Indeed, neither Nakane nor Kobayashi individually leads the skilled artisan to cover a base powder with 5-50% (by surface area) of zinc oxide. This teaching comes only from applicant's disclosure. Therefore, this does not mean the claimed subject matter is obvious, rather it is indicative of invention.

Based on the foregoing, Applicants assert the patentability of claims 1 and 12 over Nakane and Kobayashi, in any combination. Because claims 7-11 depend from claim 1, Applicants submit that they are similarly patentable. Applicants respectfully request withdrawal of the rejection.

***Conclusion***

In light of the foregoing, it is respectfully submitted that the present application, including claims 1 and 7-12, is in a condition for allowance and notice to that effect is hereby requested. If it is determined that the application is not in a condition for allowance, the Examiner is invited to initiate a telephone interview with the undersigned attorney to expedite prosecution of the present application.

If there are any additional fees resulting from this communication, please charge same to our Deposit Account No. 18-0160, our Order No. IWI-16057.

Respectfully submitted,

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